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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,737	12/12/2001	Mitchell T. Weisman	10005.000200	1057
31894	7590	12/18/2006	EXAMINER	
OKAMOTO & BENEDICTO, LLP P.O. BOX 641330 SAN JOSE, CA 95164			BEKERMANN, MICHAEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 12/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/021,737	WEISMAN ET AL.	
	Examiner	Art Unit	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-11 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-11 and 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to papers filed 9/26/2006.

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1, 7, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 1, 7, and 14, these claims recite the limitation that the delivery of advertising (or additional member items) is "not inextricably tied to a particular member item". If the presence of a member item is detected, then that member item is inherently tied to the delivery of advertising or additional member items. It is unclear how a member item is able to not be tied to the delivery when the delivery is based on the member item itself.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 3-5, 7-10, and 13-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Fuller (U.S. Patent No. 6,216,112).** Fuller teaches an adware program that includes all of the limitations recited in the above claims.

Regarding claims 1, 3, 4, 7-9, 13-18, and 20-22, Fuller teaches making adware software and an accompanying plug-in (member items) available over a computer network, downloading the software and plug-in combination to a computer (Column 3, Lines 19-22), and delivering advertising to the computer (advertising updates are software packets considered to be in the same group as the original downloaded software, and are therefore additional member items) even if the original software is not being executed (a web browser connects to the internet to download [deliver] advertisement updates) (Column 3, Lines 47-57). If the plug-in module that downloads the advertisements is uninstalled from the system, no further advertisement updates will be downloaded. Fuller teaches users going to a web page (server) and choosing which software they want (Column 3, Lines 19-22). Fuller also teaches different advertisements being combined with different software (Column 7, Lines 53-54). Thus,

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this reads on advertising that is selected based on a web page viewed by a user. Since every business inherently has a competitor, the server hosting the software is considered to be a "competitor of a company", and the advertising is delivered on behalf of the server (competitor) webpage. Examiner asserts that since delivery of advertising is based on the detection of a member item, that a member item is indeed being utilized in applicant's invention. Further, applicant's invention appears to deliver advertising after the detection of a member item without any limitation. Since Fuller relies on the detection of the plug-in to deliver advertising (additional member items), Fuller appears to meet this limitation in the same way as applicant's invention.

Regarding claims 5 and 10, Fuller teaches a list of adware programs that are downloaded onto the user computer (Column 11, Lines 7-9).

Regarding claim 19, the terms "competitor" and "same type" are very broad. Any product may be interpreted as a competitor of another product. Fuller teaches advertising provided on behalf of a company.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuller (U.S. Patent No. 6,216,112).**

Regarding claim 12, Fuller doesn't specify an advertisement as being delivered via pop-up. Official notice is taken that it is old and well known to display advertisements on a computer via pop-ups. It would have been obvious to one having ordinary skill in the art at the time the invention was made to display the advertisement in a pop-up window. This feature would help to draw the user's attention towards the advertisement.

Response to Arguments

In response to the objection to the disclosure, applicant argues that the hyperlinks are not active links and they are required to comply with 112 1st paragraph. Page 6, Line 5 of the specification recites www.gator.com. It is unclear why the recitation of this URL is needed to comply with 112 1st. Further, the multiple URL recitations on Page 9 of the specification do not appear to be needed to comply 112 1st. Therefore, the hyperlinks are still in need of being removed.

In response to applicant's arguments regarding the above 102 rejections, Examiner asserts that since delivery of advertising is based on detection of a member item, that member items are indeed utilized in applicant's invention. Fuller also detects the presence of the plug-in before downloading advertisements, and therefore appears to meet the claim language in the same way.

Further, applicant's invention appears to deliver advertising after the detection of a member item without any further limitation. Examiner presents the following example: If a child makes the statement "I want a piece of candy", and follows that statement with

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"even if the candy is licorice", the second statement does not change the fact that the child wants a piece of candy. If a piece of candy is supplied to the child, the candy will meet the child's expectations whether it is licorice or chocolate. Effectively, the child places no limitation on the requested candy. This is the same conclusion the Examiner draws from applicant's claim of "even if no member item is being utilized". Whether or not running member items are present on the system of Fuller appears to be inconsequential. Therefore, Fuller still reads on applicant's invention.

In response to Examiner's interpretation of advertising based on web pages viewed, Applicant argues "Fuller does not even monitor the web pages viewed by a user to take advantage of that information in selecting advertisements to be embedded into an adware program". Applicant has not claimed any such monitoring of web pages. If a user of the system of Fuller had not viewed the webpage to download the original adware program, then that user would not get the advertisements in the adware program. Since the advertisements are downloaded because of the presence of the plug-in, the advertisements are based on the original website from which the software was obtained. This meets the limitation as currently recited in the claim.

Conclusion

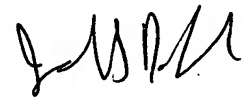
5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



JEFFREY D. CARLSON
PRIMARY EXAMINER

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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